



AF 12834

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **SHIMIZU, Motohiro et al.**

Serial No.: **09/880,076**

Group Art Unit: **2834**

Filed: **June 14, 2001**

Examiner: **Leda T. Pham**

**P.T.O. Confirmation No.: 3823**

For: **ENGINE OPERATED GENERATOR**

**REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.116**

**- EXPEDITED RESPONSE -**

**GROUP ART UNIT 2834**

**BOX AF**

Commissioner for Patents  
Washington, D.C. 20231

April 4, 2003

Sir:

In response to the Office Action dated **January 8, 2003**, please consider the remarks which follow:

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**REMARKS**

It is believed that this Amendment is fully responsive to the Office Action dated **January 8, 2003**.

**Examiner Interview**

Applicant's representative wishes to thank the Examiner for the personal interview conducted on March 27, 2003. This interview served to clarify the outstanding issues and this after final request for reconsideration is the result of that interview.

**Claim Rejections under 35 USC §103**

In the Office Action mailed January 8, 2003, Claims 1-10 are rejected under 35 USC §103(a) as being unpatentable over Shimizu et al. (U.S. Patent No. 6,130,486) in view of Wakashiro et al. (U.S. Patent No. 6,424,053 B1).

It should be noted that *at the time invention was made* the present patent application was under obligation of assignment to Honda Giken Kogyo Kabushiki.

Under 35 USC § 103 (c), at the very least, Wakashiro et al. and Shimizu et al. may not be used as prior art in a rejection under 35 USC § 103 (a). 35 USC § 103 (c) states that:

**(c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis Added)**

Wakashiro et al. issued as a Patent on July 23, 2002, and was filed on October 4, 2000.

The present application was filed on June 14, 2001, with a priority date of June 30, 2000.

Therefore, in order to qualify as prior art under 35 USC § 103(a), Wakashiro et al. must qualify under 35 USC § 102(e). Since both the present application and Wakashiro et al. were under obligation of assignment at the time the invention was made to Honda Giken Kogyo Kabushiki, Wakashiro et al. may not be used as prior art due to 35 USC §103(c).

In addition, if the priority date of June 30, 2000 is taken as the date of an invention under 35 USC § 102(e), then Shimizu et al. also may not be used as prior art under 35 USC § 103(c) for the same reasons. Please note that Shimizu et al. issued as a Patent on October 10, 2000 and was filed on March 30, 1999. Therefore, taking the priority date as the date of invention, Shimizu et al. only qualifies as prior art under 35 USC § 102(e). Therefore, since both the present application and Shimizu et al.. were under obligation of assignment at the time the invention was made to Honda Giken Kogyo Kabushiki, Shimizu et al. may not be used as prior art under 35 USC § 103(c).

**Conclusion**

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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